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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,756	12/03/2003	Frederick James Diggle III	030579	4220

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EXAMINER

NGUYEN, CHAU N

ART UNIT	PAPER NUMBER
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2831

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,756

Applicant(s)

DIGGLE ET AL.

Examiner

Chau N Nguyen

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,10-13,15-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,8,10,11,16,17 and 19 is/are rejected.
- 7) ☒ Claim(s) 3,6,12,13 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Patel (3,708,864).

Patel discloses a device comprising an elongate member (14) having a first end portion and a second end portion adjacent to the first end portion, wherein the second end portion is adapted to removably engage a raceway member, the elongate member defining an axial passageway for receiving a cable therethrough, wherein the axial passageway has a pre-determined cross-sectional geometry in a plane perpendicular to the axial passageway and wherein the axial passageway has a coating of a dry film lubricant (49) (re claim 1). Patel also discloses the cross-sectional geometry of the axial passageway being circular (re claim 2), the elongate member being fabricated from a metal (re claim 8), the elongate member defining an axial slot wherein the cable may be received into the axial passageway by

aligning the cable with the axial slot and inserting the cable therethrough (re claim 10).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel.

Claim 5 in addition to the limitations of claim 1 recites the cross-sectional geometry of the axial passageway being polygonal. Although not specifically disclosed by Patel, it would have been obvious to one skilled in the art to modify the cross-sectional geometry of Patel to be polygonal to meet the specific use of the resulting device since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ 47.

Re claim 7, it would have been obvious to one skilled in the art to use plastic for the elongate member of Patel to meet the specific use of the resulting device since plastic elongate member is known in the art for being used to receive cables therethrough and since it has been held that within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. *In re Leshin*, 125 USPQ 416.

6. Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phipps (2003/0230343) in view of Patel.

Phipps discloses a device comprising the invention substantially as claimed including the cross-sectional geometry of the axial passageway being circular (re claim 2) and the second end portion comprising a tapered portion (re claim 4).

Phipps does not disclose a dry film of lubricant being provided in the axial passageway. Patel discloses a device comprising a dry film of lubricant (49) being provided in the axial passageway of an elongate member (14). It would have been obvious to one skilled in the art to provide a dry film lubricant as taught by Patel in the axial passageway of Phipps to reduce friction between the inner surface of the member and the outer surface of the object being pulled therethrough.

7. Claims 11, 16, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stout, Jr. (6,548,760) in view of Patel.

Stout, Jr. discloses the invention substantially as claimed including the cross-sectional geometry of the axial passageway through the first end portion increases in area in a direction away from the second end portion (re claim 11), the member being fabricated from a metal (re claim 17), the member defining an axial slot whereby cable may be received into the passageway by aligning cables with the axial slot and inserting cables therethrough (re claim 19). Stout, Jr. does not disclose the passageway having a coating of a dry film lubricant. Patel discloses a device comprising a dry film of lubricant (49) being provided in the axial passageway of an elongate member (14). It would have been obvious to one skilled in the art to provide a dry film lubricant as taught by Patel in the axial

passageway of Stout, Jr. to reduce friction between the inner surface of the member and the outer surface of the object being pulled therethrough (re claim 11). Re claim 16, it would have been obvious to one skilled in the art to use plastic for the elongate member of Stout, Jr. to meet the specific use of the resulting device since plastic elongate member is known in the art for being used to receive cables therethrough and since it has been held that within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

8. Claims 3, 6, 12, 13 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or suggest a device comprising all the features as recited in the claims and in combination with the second end portion comprising a first threaded portion and the raceway member comprising a second threaded portion, wherein the second end portion may threadingly engage the second threaded portion of the raceway member (re claims 3 and 12), the

second end portion comprising a tapered portion (re claims 6 and 13), and the cross-sectional geometry of the passageway through the first end portion increasing non-linearly in area in a direction away from the second end portion (re claim 15).

Response to Arguments

10. Applicant's arguments with respect to claims 1 and 11 have been considered but are moot in view of the new ground(s) of rejection.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N Nguyen whose telephone number is 571-272-1980. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Chau N Nguyen
Primary Examiner
Art Unit 2831